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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Takao HAMAKUBO et al.

Group Art Unit : 1648

Serial No : 09/884,481

Examiner : Foley

Filed : June 20, 2001

For : A METHOD FOR THE EXPRESSION AND PURIFICATION OF A PROTEIN
USING BUDDED BACULOVIRUS

ELECTION WITH TRAVERSE

Commissioner of Patents and Trademarks
Washington, D.C. 20231

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Sir:

This is in response to the requirement for restriction and election of species under 35 U.S.C. 121 mailed from the U.S. Patent and Trademark Office on October 2, 2002, which sets a one month shortened statutory period for response until November 2, 2002.

With November 2, 2002 being a Saturday, in accordance with the provisions of 37 C.F.R. 1.7, this election is timely filed on the next business day, Monday, November 4, 2002.

Because this response is being filed by the initial due date, an extension of time should not be necessary. However, if any extensions of time are necessary to maintain the pendency of this application, this is an express request for any required extension of time, and authorization to charge Deposit Account No. 19-0089 any required extension of time fee.

Reconsideration and withdrawal of the restriction requirement and requirement for election of species is respectfully requested in view of the remarks which follow:

DISCUSSION OF RESTRICTION REQUIREMENT

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-8, drawn to a method of expressing and making a protein, classified in class 435, subclass 69.1.
- II. Claim 9, drawn to a budded baculovirus, classified in class 435, subclass 235.1
- III. Claims 10 and 11, drawn to a method of screening a chemical substance against a protein and a budded baculovirus, classified in class 435, subclass 4.
- IV. Claim 12, drawn to a method of screening a chemical substance against at least two proteins and a budded baculovirus, classified in class 435, subclass 4.
- V. Claim 13, drawn to a method of making an antibody, classified in class 435, subclass 326.
- VI. Claim 14, drawn to an antibody, classified in class 530, subclass 387.1.

The Examiner has also required that if one of Groups 1-5 is elected that an election of species also be made.

Election

In order to be responsive to the requirement for restriction and election of species, Applicants elect the invention set forth in Group I, claims 1-8, and as required upon election of Group I a species of protein listed therein comprising a membrane-bound enzyme, with traverse. Applicants respectfully submit that at least claims 1-8 are generic, and that all of the claims are examinable with the elected species for the reasons set forth herein.

Traverse

Notwithstanding the election of the claims of Group I and the species of species of membrane-bound enzyme, in order to be responsive to the Restriction Requirement, Applicants respectfully traverse the requirement.

Initially, it is pointed out that the requirement for restriction omits one of the two criteria of a proper requirement as now established by U.S. Patent and Trademark Office policy, as set forth in MPEP 803, viz. that "an appropriate explanation" must be advanced by the Examiner as to the existence of a "serious burden" if a restriction were not required. Due to the aforementioned omission, it is respectfully submitted that the requirement for restriction is improper and, consequently, its withdrawal is respectfully requested.

Related to this, the requirement is traversed since there would not appear to be a serious burden to examine Applicants' application in total, and for which they have paid the appropriate claim fees. Applicants submit that it would be no serious burden on the Examiner to examine all of the pending claims, because a search for all of the claims in the above-identified application, should be made in order to do a complete and thorough search in view of the recognized relationship between the claims in Groups I, II, III, IV, V and VI.

With regard to the groups of invention, Applicants respectfully submit that the Groups of invention are related to each other. For example, the claims of Group I are directed to a method for expressing a protein wherein, amongst other features, the protein is express in a budded baculovirus related from the host; the claim of Group II is directed to a budded baculovirus which is release from a host infected with at least one type of baculovirus which contains a gene

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encoding a protein; the claims of Group III are directed to a method for screening a chemical substance using the budded baculovirus of claim 9; the claim of Group IV is directed to a method for screening a chemical substance which activates or inhibits the function of two or more proteins including co-infecting two or more different types of recombinant baculoviruses; the claim of Group V is directed to a method for producing an antibody against a protein wherein the budded baculovirus of claim 9 is used as an immunogen; and the claim of Group VI is directed to an antibody which is produced by the method of claim 13.

Accordingly, for at least the fact that the reason for the requirement is without appropriate basis, the requirement should be withdrawn.

Moreover, with regard to the requirement for election of species, Applicants respectfully submit that there is no burden to examine each of Applicants' species in the present application.

In any event, Applicants respectfully request that each of the non-elected claims be rejoined upon allowance of the claims in the elected group of invention and the elected species.

In view of the foregoing, it is respectfully requested that the Examiner seriously reconsider his requirement for restriction and election of species, and withdraw the same so as to give an examination on the merits on all of the claims pending in this application.

CONCLUSION

For the reasons discussed above, it is respectfully submitted that the requirement for restriction and election of species is improper and should be withdrawn.

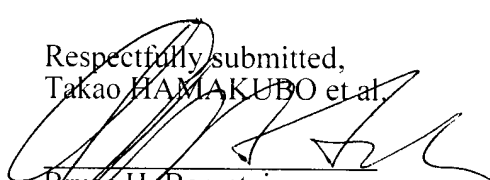
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Withdrawal of the requirement for the restriction and election of species with the examination of all claims pending in this application is respectfully requested.

Favorable consideration with early allowance of the claims is most earnestly requested.

If the Examiner has any questions, or wishes to discuss this matter, please call the undersigned at the telephone number indicated below.

Respectfully submitted,
Takao HAMAKUBO et al.


Bruce H. Bernstein
Reg. No. 29,027

November 4, 2002
GREENBLUM & BERNSTEIN, P.L.C.
1941 Roland Clarke Place
Reston, VA 20191
(703) 716-1191

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